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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,284	10/11/2000	Andrea C. Hughs-Baird	0112300/143	5144
29159	7590	02/06/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			ASHBURN, STEVEN L	
			ART UNIT	PAPER NUMBER
			3714	28
DATE MAILED: 02/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/686,284

Applicant(s)

HUGHS-BAIRD, ANDREA C.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION******Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2003 has been entered.

***Claim Rejections - 35 USC § 103***

**Claims 1, 2, 5, 8-11, 15, 20, 23, 27, 29, 30 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al., U.S. 6,322,309 (Nov. 27, 2001) in view of Fier, U.S. Patent 6,126,542 (Oct. 3, 2000)**

In regards to claims 1, 10, 20, 27, 29, 36 and 37: *Thomas* teaches a gaming device having a selection-type bonus game wherein a plurality of hidden selections associated with symbols are presented on a display and players successively pick selections to generate outcomes. If the player selects a credit symbol, he is awarded a payoff. If a player selections a terminating symbol, the game ends. In an embodiment based on the board game MONOPOLY™, in which certain selections are associated in sets and players are awarded an additional payoff when a set is completed. *See col. 11:38-65*. In particular regards to the claims, the reference describes the following features:

- a. A bonus round triggered by a primary game. *See col. 5:25-36*.
- b. A plurality of selections displayed to the player. *See fig. 8, 9*.
- c. A first plurality of credit symbols associated with the selections and a second plurality of award symbols associated with selections. *See col. 11:18-65*.

- d. Picking one of the selections and displaying a symbol associated with the picked selection. *See col. 10:30-65.*
- e. Accumulating the symbol if the symbol is associated with an award selection and providing the player an award if the symbol is a credit symbol. *See col. 11:38-65.* More specifically, the MONOPOLY™ embodiment provides a selection-type bonus game having more than one type of symbols including properties, utilities, railroads, and end-game symbols. *See id.* All symbols except end-game symbols are associated with an award. *See id.* Property symbols may be collected to complete sets. *See id.* If a set of property symbols is completed, the player is issued an additional award. *See id.* Hence, property symbols constitute a plurality of award symbols and other selections constitute a plurality of credit selections.
- f. A winning combination of award symbols. *See id.*
- g. A display device adapted to display selections, credit symbols and award symbols to a player. *See fig. 8, 9, 12-14.*
- h. A processor that communicates with the display device, provides a number of credits to the player when the player chooses each of the selections having an associated credit symbol, and provides the player an award when the accumulated award symbols reach a winning combination. *See id.*
- i. Providing the player a number of picks from the display; crediting the player an amount associated with each pick having an associated credit symbol; accumulating the award symbols from each pick having an associated award symbol; and providing the player an award based on the number of accumulated award symbols wherein the award increases non-linearly as the number of accumulated award symbols increases. *See fig. 8; col. 9:55-11:65.*

However, *Thomas* lacks the feature of providing a jackpot award when accumulated award symbols reach a winning combination wherein (i) all but one of a provided number of player picks must result in a

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winning combination of award symbols, and (ii) when all of the provided player picks must result in a winning combination of award symbols. Regardless, as discussed below, would have been obvious to an artisan in view of *Fier*.

*Fier* discloses an analogous gaming device offering a primary and secondary game. *See abstract*. When the player obtains a predetermined outcome in the primary game, a secondary game is initiated wherein the player is presented with a plurality of hidden selections. *See id.* The player selects symbols that reveal the selected hidden values. *See id.* If the selected values correspond to a winning combination, the player receives an additional reward. *See id.* In regard to the claimed features, *Fier* describes a jackpot award associated with the winning combination of award symbols wherein all picks must result in award symbols to achieve the winning combination and the number of picks is more than two. *See col. 7:28-9:7*. More specifically, the bonus game allows a player to make five selections. *See id.* If all the selections result in a particular winning combination (e.g. Royal Flush), the player is awarded a jackpot. *See id.* Furthermore, it is inherent that all but one of a provided number of player picks must result in a winning combination of award symbols to receive a jackpot. For example, in a game offering five picks and requiring five award symbols to receive a jackpot, a player must select four award symbols in his first four picks to achieve a jackpot upon his pick of a fifth award symbol. Hence, *Fier* describes the features of providing a jackpot award when accumulated award symbols reach a winning combination wherein (i) all but one of a provided number of player picks must result in a winning combination of award symbols, and (ii) when all of the provided player picks must result in a winning combination of award symbols.

In view of *Fier*, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by *Thomas*, wherein award symbols are accumulated to provide an additional award in a selection-type bonus game, to add the feature of providing a jackpot award when accumulated award symbols reach a winning combination wherein (i) all but one of a provided number of player picks

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must result in a winning combination of award symbols, and (ii) when all of the provided player picks must result in a winning combination of award symbols. As suggested by *Fier*, the modification would enhance players' attraction to the gaming device by offering large, secondary awards. *See col. 2:11-26*. As a result, operator revenue would increase due to the additional player interest.

Claims 2, 9 and 28: *Thomas* discloses accumulating awards associated with subsequent selections wherein credits may be associated with any of the selected outcomes. *See col. 11:18-65*.

Claims 5, 15 and 23: *Thomas* discloses a functional symbol associated with one of the selections. *See col. 12:6-24*. More specifically, *Thomas* discloses a functional "party pooper" symbol performing the function of ending the player's selections. *See id.*

Claims 8 and 37: *Thomas* discloses a plurality of related award symbols defining winning combinations of award symbols that can be selected within the number of picks. *See id.*

Claim 11: *Thomas* discloses enabling players to pick selections. *See col. 10:30-65*.

Claim 29: In addition to the features described for claim 1, *Fier* additionally teaches the number of possible selectable award symbols is the predetermined number of picks. *See col. 5:40-52*. More specifically, the game requires players to select the five award symbols associated with a Royal Flush in the five given selections.

Claim 30: *Fier* discloses an award for collecting award symbols that is jackpot. *See col. 7:40-8:18*.

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Claim 28: *Thomas* discloses accumulating awards associated with subsequent selections wherein credits may be associated with any of the selected outcomes. *See col. 11:18-65.*

**Claims 3, 4, 12, 13, 21, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Fier*, as applied to claims 1, 10, 20 and 29 above, in further view of Mayerhoff, U.S. Patent 6,231,442 (May 15, 2001).**

Claims 3, 12, 21 and 31: The gaming device suggested by the combination of *Thomas* with *Fier* describes all the features of the claims except determining the number of selections in the bonus game based on player's wager in the primary game. *Mayerhoff* discloses a gaming device with an analogous selection-type bonus scheme. The number of selections in the bonus game is based on the player's wager in the primary game. *See col. 7:47-52.* *Mayerhoff* suggests that this method motivates players to increase their primary wagers. *See col. 3:57-60.* In view of *Mayerhoff*, it would have been obvious to one skilled in the art at the time of the invention to modify the selection game described by the combination of *Thomas* with *Tic-Tac-Dough* and *Walker* to add the features of basing the number of selections in the bonus on the player's wager in the primary game to motivate players to increase their wagers to gain more selections to receive greater odds of a bonus payoff and thereby increase operator revenue from the increased wagers.

Claims 4,13 and 32: *Fier* additionally describes providing a sufficient number of selections to allow the player to select award symbols necessary for obtaining a winning combination. *See col. 7:28-39.*

**Claims 6, 7, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Fier*, as applied to claims 1, 10, 20 and 29 above, in further view of Bennett, U.S. Patent Application Publication 2003/0073481 A1 (Apr. 17, 2003).**

Claims 6 and 24: The selection game described by the combination of *Thomas* with *Fier* describes all the features of their respective claims except functional symbols that change the total number of selections. *Bennett* discloses an analogous selection-type game in which selections include functional symbols that change the total number of selections available to the player. *See fig. 4; ¶¶ 13, 29.* In view of *Bennett*, it would have been obvious to an artisan at the time of the invention to modify the gaming device suggested by the combination of *Thomas* and *Fier*, wherein players make a predetermined number of selections in a bonus game including functional symbols, to add the feature of functional symbols that change the total number of selections. As taught by *Bennett*, the modification would make the game more interesting by adding additional twists that increase a player's interest in the game. *See id.*

Claims 7 and 25: *Bennett* additionally teaches a functional symbols being a modifier symbol (e.g. bonus, penalty). *See id.*

**Claims 16, 17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable *Thomas* with *Fier*, as applied to claims 1, 10, 20 and 29 above, in further view of Holmes, U.S. 5,882,259 (Mar. 16, 1999); and**

**Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable *Thomas* with *Fier* and *Mayerhoff*, as applied to claim 12 above, in further view of Holmes, U.S. 5,882,259 (Mar. 16, 1999).**



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The selection game described by the combination of *Thomas* with *Fier* or the combination of *Thomas* with *Fier* and *Mayerhoff* describes all the features of their respective claims except a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections. *Holmes* discloses an analogous gaming device where a player selects a set of choice from a matrix a available choices. In particular, a matrix of all possible selections is displayed to the player. *See fig. 3; col. 2:38-3:5*. The player selects a predetermined number of choices and presses "play" to initiate the game after the player has confirmed his choices. *See id.* Subsequently, the player is paid for receiving cards or combinations that match his selections. *See id.* It would have been obvious to one skilled in the art at the time of the invention to modify the selection-type games described the selection game described by the combination of *Thomas* with *Fier* or the combination of *Thomas* with *Fier* and *Mayerhoff* to add a selection confirmation indicator enabling the player to confirm the player's selections after the player selects all of the player's selections and a selection confirmation indicator enabling the player to confirm each selection picked by the player.

**Claims 22, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable *Thomas* with *Fier*, as applied to claims 1, 10, 20 and 29 above, in further view of Kamilie, U.S. Patent 5,092,598 (Mar. 3, 1992).**

Claims 22 and 32: The gaming device suggested by the combination of *Thomas* and *Fier* suggests all of the features of the claimed invention except limiting the predetermined number of picks to being not more than one plus the number of award symbols. *Kamilie* discloses an analogous gaming system offering a multiple-play lottery game for use as a promotional game or casino-style game. *See abstract*. The game may be played on disposable card or in a video format. *See id.* One embodiment provides a progressive format having multiple tiers each of which has multiple hidden selections which are arranged in a trapezoidal arrangement. *See fig. 1-3; col. 3:1-25*. The player picks one symbol from

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each tier. If the player picks five award symbols in five random selections, then the player is awarded a high-value award. *See id.* In an alternative embodiment, *Kamille* discloses a selection-type game in which a player is limited to ten picks to find up to ten award symbols. *See fig. 4.* In another alternative embodiment, *Kamille* discloses a selection-type game in which a player is limited to three picks to find up to three matching award symbols. *See fig. 8.* Hence, *Kamille* teaches casino games wherein a player is limited to a predetermined number of picks not being more than one plus the number of award symbols in a selection-type game having a plurality of award symbols and non-award symbols.

In view of *Kamille*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of *Thomas* and *Fier*, wherein a player makes a predetermined number of picks and is awarded an additional award if the picks complete a set of award symbols, to add the feature of limiting the predetermined number of picks to being not more than one plus the number of award symbols. Furthermore, as disclosed by *Kamille*, such games enhance a gaming device by providing operators control over large prize allocations, while simultaneously providing the player with the impression of self-determination. *See col. 1:40-46.*

**Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Thomas* with *Fier*, as applied to claims 1, 10, 20 and 29 above, in further view Walker, U.S. 6,001,016 (Dec. 12, 1999).**

The gaming system suggested by the combination of *Thomas* and *Fier* describes all the features of the claims except operating the game through a network or Internet. *Walker '016* discloses a system for remote gaming over a network. The system can operate over both local and Internet network systems. *See col. 3:60-4:8.* *Walker '016* explains the benefits allow players to play a variety of games from a remote location. *See col. 1:19-34.* In view of *Walker '016* it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the selection game described by the combination of

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*Thomas* with *Fier* to allow a greater number of players to access games from remote locations over a network connection and thereby generate greater revenue for the operator.

### ***Response to Arguments***

Applicant's arguments filed November 19, 2003 have been fully considered but they are not persuasive. In particular, the applicant asserts that the amended claims, as proposed in the telephone interview with the examiner on October 17, 2003 (paper no. 21), overcome the prior art because the combination of *Thomas* in view of *Fier* does not describe the feature of providing a jackpot award when accumulated award symbols reach a winning combination wherein all but one of a provided number of player picks must result in a winning combination of award symbols. The examiner respectfully disagrees because the claims, as amended, fail to overcome the prior art. In particular, it is inherent in *Feir* that all but one of a provided number of player picks must result in a winning combination of award symbols to receive a jackpot. For example, in a game offering five picks and requiring five award symbols to receive a jackpot, a player must select four award symbols in his first four picks to achieve a jackpot upon his pick of a fifth award symbol. Hence, *Fier* describes the features of providing a jackpot award when accumulated award symbols reach a winning combination wherein (i) all but one of a provided number of player picks must result in a winning combination of award symbols, and (ii) when all of the provided player picks must result in a winning combination of award symbols.

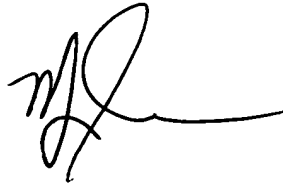
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

s.a.

A handwritten signature in black ink, appearing to read 'MS', with a long horizontal flourish extending to the right.

**MARK SAGER  
PRIMARY EXAMINER**